

REMARKS

Claims 1 through 34 are pending in this Application. Applicants acknowledge, with appreciation, the Examiner's indication that claim 15 contains allowable subject matter.

Claims 1, 16, and 32 through 34 have been amended. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment is apparent throughout the originally filed disclosure. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 33 and 34 were rejected under 35 U.S.C. 101.

This rejection is respectfully traversed. Claims 33 and 34 have been amended to recite a "non-transitory computer-readable storage medium." Clearly this subject matter is within 35 U.S.C. § 101 because a non-transitory storage medium would not include transitory signals. Therefore, it is respectfully requested that the rejection of claim 33 and 34 be withdrawn.

Claim 33 and 34 were rejected under 35 U.S.C. 112.

This rejection is respectfully traversed. The Examiner argued that there is no support in Applicants' Specification for the claimed computer-readable storage medium, (*See* Office Action, page 4). It is noted, however, that "[n]ot every last detail is to be described, else patent specifications would turn into production specifications, which they were never intended to be." *In re Gray*, 309 F.2d 769, 774 (C.C.P.A. 1962). In fact, "[a] patent is not a scientific treatise, but a document that presumes a readership skilled in the field of the invention." *Ajinomoto Co. v. Archer-Daniels-Midland Co.*, 228 F.3d 1338, 1347 (Fed. Cir. 2000), *cert. denied*, 532 U.S. 1019 (2001) (citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1556 (Fed. Cir. 1983) (holding that "[p]atents, however, are written to enable those skilled in the

art to practice the invention, not the public”), *cert. denied*, 469 U.S. 851 (1984)). With respect to computer programs and mediums for storing such programs, an applicant need only describe the functional aspects and the execution of those aspects by, for example, a device (e.g., computing hardware) in order for one of ordinary skill in the art to understand that such functions may be carried out by a computer program embodied on a computer readable medium. *See, e.g., Robotic Vision Sys. v. View Eng’g, Inc.*, 112 F.3d 1163, 1166 (Fed. Cir. 1997); *Fonar Corp. v. General Elec. Co.*, 107 F.3d 1543, 1549 (Fed. Cir. 1997); *In re Hayes Microcomputer Prods., Inc.*, 982 F.2d 1527, 1537-38 (Fed. Cir. 1992).

With these legal tenants in mind, Applicants particularly note that the disclosed embodiments have been thoroughly described with respect to a “computer program product comprising: computer program code” as recited in paragraphs 31 through 38 of the published application and claims 33 and 34 of the originally filed application. Applicants, therefore, submit that the rejection of claims 33 and 34 is not viable and, hence, should be withdrawn.

Claims 1, 10 through 13, 16, 17, 26 through 28, and 30 through 34 were rejected under 35 U.S.C. 102(b) as anticipated by Thro (“Thro”).

This rejection is respectfully traversed.

The factual determination of lack of novelty under 35 U.S.C. §102(b) requires the identical disclosure in a single reference of each element of a claimed invention, as those elements are set forth in the claims, such that the claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1308, (Fed. Cir. 2008); *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367 (Fed. Cir. 2002); *Candt Tech Ltd. v. Resco Metal & Plastics Corp.*, 264 F.3d 1344 (Fed. Cir. 2001). There are fundamental

differences between the claimed inventions and Thro that scotch the factual determination that Thro discloses, or even remotely suggests, the identically claimed inventions.

Specifically, independent claim 16, recites, *inter alia*, “**determining to transfer a list indicating the order of preference for the electronic mail messages** for the user to the mobile station.” (Emphasis added). Claims 1, 17, and 31 through 34 include similar language. These claim features are neither disclosed nor suggested by Thro.

In the statement of the rejection, the Examiner asserted that Thro discloses transferring a list indicating the order of preference for the electronic mail messages for the user to the mobile station reciting, on page 6 of the Office Action, that “invention is clearly capable of this functionality – see 68 & 82 in fig. 2.” However, the paragraphs of Thro referenced by the Examiner have no indication of the **list being transferred to the mobile station**. In fact Thro clearly states that “The server uses the tables of FIG. 2 to **establish the recipient priority** or the priority matrix.” (Emphasis added) (col.4, lines 60-61). The priority matrix is a component on the server side (106 in FIG. 3), not at the mobile station. Thus, instead of transferring the list to the mobile station, Thro utilizes the priority matrix to send notices of received messages.

The above argued functionally significant differences between the claimed features and Thro undermine the factual determination that Thro discloses the identically claimed features. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1, 10 through 13, 16, 17, 26 through 28, and 30 through 34 under 35 U.S.C. §102(b) for lack of novelty as evidenced by Thro is not factually viable and, hence, solicit withdrawal thereof.

Claims 2 through 9, and 18 through 25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Thro in view of Horvitz (“Horvitz”).

In the statement of the rejection, the Examiner asserted that one having ordinary skill in the art would have been led to modify Thro by applying at least one algorithm, in view of Horvitz. This rejection is respectfully traversed.

Specifically, claims 2 through 9 depend from independent claim 1, and claims 18 through 25 depend from independent claim 17. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of independent claims 1 and 17 under 35 U.S.C. §102(b) for lack of novelty as evidenced by Thro. The secondary reference to Horvitz does not cure the previously argued deficiencies of Thro. Accordingly, even if the applied references are combined as proposed by the Examiner, and Applicants certainly do not agree that the requisite basis to support the asserted motivation has been established, the claimed inventions would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir. 1988).

Applicants, therefore, submit that the imposed rejection of claims 2 through 9 and 18 through 25 under 35 U.S.C. §103(a) for obviousness predicated upon Thro in view of Horvitz is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 14 and 29 were rejected under 35 U.S.C. §103(a) for obviousness predicated upon Thro in view of Tarnanen et al. (“Tarnanen”).

This rejection is respectfully traversed.

Specifically, claim 14 depends from independent claim 1 and claim 29 depends from independent claim 17. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of independent claims 1 and 17 under 35 U.S.C. §102(b) for lack of novelty as evidenced by Thro. The secondary reference to Tarnanen does not cure the

previously argued deficiencies of Thro. Accordingly, even if the applied references are combined as proposed by the Examiner, and Applicants certainly do not agree that the requisite basis to support the asserted motivation has been established, the claimed inventions would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp., supra.*

Objection to claim 15.

This objection is respectfully traversed. Claim 15 was objected to for being dependent upon a rejected base claim. Claim 15 depends from claims 2 and 1, which are allowable for the aforementioned reasons. Accordingly, withdrawal of the objection of claim 15 is solicited.

Therefore, the present application, as amended, overcomes the objections and rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 519-9952 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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